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10/002,459	11/15/2001	Ronald J. Skrzyniarz	1945.BDM	3576

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EXAMINER

YAO, SAMCHUAN CUA

ART UNIT	PAPER NUMBER
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1733

DATE MAILED: 08/29/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

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# Office Action Summary

Application No.

10/002,459

Applicant(s)

SKRZYNIARZ ET AL.

Examiner

Sam Chuan C. Yao

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 15 November 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 15-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☒ Claim(s) 12-14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-14, drawn to adhesive and articles thereof, classified in class 524, subclass 459.
  - II. Claims 15-20, drawn to a method for bonding materials, classified in class 156, subclass 327.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the product as claimed can be used in a materially different process of using that product such as using the recited adhesive as a sealant for small openings **or** using the recited adhesive to bond layers without subjecting the adhesive to conditions which allow the adhesive to cool.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Ms Cynthia Foulke on 08-18-03 a provisional election was made **without** traverse to prosecute the invention of Group I,

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claims 1-14. Affirmation of this election must be made by applicant in replying to this Office action. Claims 15-20 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 6 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 6 and 9 are indefinite because it is unclear what is intended by "*the adhesive is foamed from about 20 to about 60% weight per volume*". Does this limitation require that, the solid resin in an adhesive foam is around the recited range?

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-3, 10 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by EP 0,930,350 A1. See page 2 full paragraph 0003 and 0023.

10. Claims 1-2, 10 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Lenney et al (US 4,921,898). See abstract; column 1 lines 12-16; column 2 lines 59-68; column 4 lines 55 to col. 4 line 39; column 13 lines 55-60.

11. Claims 1-4, 7, 10 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Knutson (US 3,734,819). See column 1 lines 67-67; column 2 line 61 to column 3 line 53; column 9 lines 1-23; column 10 lines 18-65; column 13 lines 12-15; claim 1.

### ***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yeo et al (US 5,695,855) in view of Lenney et al (US 4,921,898) and Knutson (US 3,734,819).

With respect to claims 1-2 and 4-5, Yeo et al discloses a water-based adhesive-based ink comprising a binder, where examples of a suitable binder are:

*"polyvinyl alcohol, ethylene vinyl acetate ..."* (col. 2 line 53 to col. 3 line 20). Yeo

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et al further teaches that when a water-based binder is used, a foaming agent may be included in the adhesive-based ink formulation (col. 3 lines 14-15). It would appear that it is envisioned by Yeo et al to combine a polyvinyl alcohol (PVOH) and ethylene vinyl acetate (EVA) as evidence from the following passage: "*The solids level of these binder polymers (PVOH and EVA) in the adhesive-based ink ...*" (emphasis added). In any event, it would have been obvious in the art to combine a polyvinyl alcohol particularly a fully hydrolyzed PVOH and ethylene vinyl acetate in making an adhesive-based ink taught by Yeo et al, because: a) Lenney et al, drawn to a water-based EVA adhesive for bonding cloths, teaches incorporating a PVOH stabilizing agent to EVA in formulating the water-based adhesive (col. 3 line 55 to col. 4 line 39; col. 13 lines 55-59); and b) Knutson, drawn to a water-based EVA adhesive, teaches the advantage of incorporating a fully hydrolyzed PVOH to the EVA adhesive (col. 3 lines 38-52; col. 13 line 47 to col. 13 line 18).

With respect to claim 3, it is a notoriously common practice in the art to incorporate a filler in making an adhesive-based ink in order to reduce the cost of a resultant ink and also adjust the consistency of a binder composition.

With respect to claims 6-9, absent any showing of unexpected result/benefit, one in the art would have determined, by routine experimentation, a workable amount of foaming and composition in making a foamed binder of Yeo et al. Moreover, the recited composition is also old in the art as exemplified in the teachings of Knutson (claim 1).

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With respect to claims 10-11, see abstract.

***Allowable Subject Matter***

14. Claims 12-14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

15. The following is a statement of reasons for the indication of allowable subject matter:

Although Knutson (US 3,734,819) teaches using an ethylene-vinyl acetate adhesive, of a type similar to the one recited in the claims, for bonding substrates such as a concrete (col. 10 lines 57-64), there is no motivation to form the adhesive of Knutson into a foamable adhesive. Likewise, although Yeo et al teaches forming a foamable adhesive-based ink for non-woven webs, there is no suggestion in the art to use the adhesive-based ink for bonding a facing layer to a concrete substrate. For these reasons, the subject matter in claim 12 taken with all limitations of a base and intervening claims is allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sam Chuan C. Yao whose telephone number is (703) 308-4788. The examiner can normally be reached on Monday-Friday with second Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael W Ball can be reached on (703) 308-2058. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.



Sam Chuan C. Yao  
Primary Examiner  
Art Unit 1733

Scy  
08-18-03